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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/138,218	08/21/1998	MIKA TARKIAINEN	466-008195-U	3829

7590 11/21/2003

CLARENCE A GREEN  
PERMAN & GREEN  
425 POST ROAD  
FAIRFIELD, CT 06430

EXAMINER
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GESESSE, TILAHUN

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 11/21/2003

26

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/138,218

**Applicant(s)**

TARKIAINEN ET AL.

**Examiner**

Tilahun B Gesesse

**Art Unit**

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER
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26

DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner for Patents**

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2,4-6,9-13,15 and 17- 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ghisler (5,950,128) in view of Pepe et al "Pepe" (5,742,905).

As to claims 1,10, Ghisler discloses method using a message service for the transmission of textual user message (figure 1), containing information from a sender (subscriber A or POT 101), to the mobile station of a recipient (mobile radio terminal 107), who as a primary mobile station capable of receiving at least voice calls (107) (column 4, line 26-column 5, line 23), and at least one secondary mobile station (400), capable of receiving at least textual user messages (column 8, lines 12-25 and figure 4), comprising the step of directing textual user messages addressed to the primary mobile station to any of the secondary mobile stations of the recipient (column 4, line 46-column 5, line 23) , irrespective of whether the primary mobile station is in use and whether notification message indicating the receipt of textual use messages are used (column 4, lines 46-column 5, line 23 and figure 1).

Ghisler is silent in teaching the mobile telephone terminal capable of receiving textual message.

However, Pepe discloses PDA 30 capable of notification of a voice mail or fax messages receipt directed to a wireless PDA in the form of email message (column 6, lines 11-19 and figure 1).

Since, Ghisler, with similar field of endeavor, teaches diverting unattended call or message to a secondary "pager" as explained above, therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Ghisler and Pepe in receiving text message at the wireless PDA, as taught by Pepe, in order to easily retrieve both voice and text in a single communication device and in a less costly manner of receiving message.

As to claims 2,18 Ghisler discloses a secondary mobile station (pager) of the recipient is activated as the receiver of user messages to be transmitted to the primary mobile station so that user messages addressed to the primary mobile station are directed to the activated secondary mobile station (column 5 lines 1-23).

As to claims 4,9 and 11-12, Ghisler discloses the activation is conducted from the secondary mobile station to be activated (column 5, lines 1-23).

Claim 6, which recites the step of implementing a system, in place of method claim 1, is rejected for same reason as set forth in the claim.

Claim 15, which recites the step of implementing a system, in place of method claim 1, is rejected for same reason as set forth in the claim.

As to claims 5,13, Ghisler does not expressly disclose a computing device of the recipient for producing a notification message informing of a received user message to the recipient and to acknowledge the received user message by the recipient, and first

directing the received user message to the data computing device and, if the user message is not acknowledged by a determined time, forwarding the user message to the activated mobile station.

However, Pepe discloses a computing device of the recipient for producing a notification message informing of a received user message to the recipient and to acknowledge the received user message by the recipient, and first directing the received user message to the data computing device and, if the user message is not acknowledged by a determined time, forwarding the user message to the activated mobile station (column 21, lines 29-44).

Since, Ghisler, with similar art of endeavor, discloses redirecting call to the recipient of mobile terminal to a secondary mobile station upon the mobile terminal is off state. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Ghisler and Pep for receipt of notification the PDA sends an acknowledgement to a sender for insuring the transmission of message is received.

As to claims 8, 17, Ghisler discloses means for measuring time ((402)and producing an indication if the means for producing a notification message informing of the receipt of a user message does not produce the informing message by a determined time and means, responsive to the production of said indication by said means for measuring time for forwarding the received user message to the activated mobile station of the recipient (column 5 line 48-column 6 line 10 and figure 4)).

Ghisler does not expressly disclose a data computing device, which comprises means for receiving a user message and means for producing a notification message information of the receipt of a user message, means for first directing a user message to the data computing device.

However, Pepe discloses a data computing device,(PDA) which comprises means for receiving a user message and means for producing a notification message information of the receipt of a user message, means for first directing a user message to the data computing device (column 21 lines 29-44).

Since , Ghisler , with similar art of endeavor, discloses redirecting call to the recipient of mobile terminal to a secondary mobile station upon the mobile terminal is off state. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Ghisler and Pep for receipt of notification the PDA sends an acknowledgement to a sender for insuring the transmission of message is received.

3. Claims 3,7,14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ghisler and Pepe in further view of Nguyen (5797089).

As to claims 3,7,14 and 16, Ghisler does not expressly disclose user message on basis of the notification of calendar events.

However, Nguyen discloses cellular phone that is programmed with personal information management software application such as notepad, calendar and call to alert the subscriber that text or image are to be sent (column 1, lines 48-50 and column 2, lines 24-28 and figure 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Ghisler, Pepe and Nguyen in alerting messages based on calendar events, as taught by Nguyen, for more precise date in reminding messages to the user that the time measure includes calendar events.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

However, on page 9, second paragraph of response, applicant noted that the primary terminal is a terminal having enhanced properties "intelligent terminal" and the secondary terminal is an ordinary terminal with less properties than the primary one.

The examiner disagrees. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the primary terminal having enhanced properties "intelligent terminal") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lahtinen (5,351,235) discloses the shot message service scheme permits the sending of short messages from a call originating device to a call terminating device, even when the user of the call terminating device is not answering the call (abstract).

Doyle (5,68,196) discloses a message transferring or routing to a terminal other than terminating terminal (column 6, lines 40-48).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tilahun B Gesesse whose telephone number is 703-308-5873. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703-308-7745. The fax phone number for the organization where this application or proceeding is assigned is 703-308-6306.

Art Unit: 2684

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

TBG

November 12, 2003

Art Unit: 2684



**NAY MAUNG**  
**SUPERVISORY PATENT EXAMINER**